

Appl. No. 10/603,522
Atty. Docket No. AA597
Amdt. dated September 20, 2005
Reply to Office Action of June 20, 2005
Customer No. 27752

REMARKS

Claim Status

Claims 1 – 14 are pending in the present application. Claims 1 – 8, 12 and 14 have been objected to due to informalities within the claims. Claims 1 – 14 have been rejected under 35 U.S.C. § 103(a). No additional claims fee is believed to be due. Claims 1, 2, 8 and 14 have been amended to provide antecedent basis for certain limitations within the claims. Claim 12 has been amended to remove exemplary language from the claim. It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Claim Objections

Claim 5 has been objected to as it is unclear to determine from the test whether the claim is dependent on Claim 3 or 4. As stated in the preliminary amendment submitted on June 25, 2003, Claim 5 is dependent upon Claim 3.

Claims 1 – 8, 12 and 14 have been objected to due to informalities within the claims. With regard to Claims 1 – 8, the Action states that there is insufficient basis for claiming patentably distinguishable quantitative aspects of the claimed invention. The Action does not provide any statutory basis for this objection and appears to be reading theory from the specification into the claims. Applicant contends that theory contained within the specification cannot be read into the claims. "No applicant should have limitations of the specification read into a claim where no express statement of the limitation is included in the claim." *In re Priest*, 582 F.2d 33 (C.C.P.A. 1978). The claims of the current application are directed to the structure of an absorbent article and characteristics of that absorbent article. The claims do not mention the theory behind the structure or its characteristics. Withdrawal of this objection is respectfully requested.

The Action has noted there is a lack of antecedent basis for phrases contained in Claims 1, 2, 8 and 14. Claims 1, 2, 8 and 14 have been amended to supply antecedent basis.

The Action has noted there is exemplary language within Claim 12. Claim 12 has been amended to remove the exemplary language.

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Rejection Under 35 USC §103(a) Over Jordan in view of Haarer

Claims 1 – 14 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Jordan et al. (U.S. Patent Pub. No. 2001/0031954)(hereafter Jordan) in view of Haarer et al. (U.S. Patent No. 6,482,192)(hereafter Haarer). Applicant respectfully traverses this rejection.

To establish a case of *prima facie* obviousness, the Office must show a motivation to combine and modify the references in the manner claimed and a reasonable expectation of success resulting from the combination and modification. This suggestion of the desirability of the combination and modification must come from the teachings of the prior art itself and not from the Applicant's own disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). The Office has not established a *prima facie* case of obviousness because there is no evidence of a motivation to combine the references.

The mere fact that the references can be combined does not render the invention obvious, unless the prior art also suggests the desirability of the combination. Jordan teaches a training pant with graphics that are disposed on the outer cover. The teachings of Jordan are focused on registered outer cover graphics and wetness indicating graphics. (Page 6, Para 0077). Thus, Jordan teaches graphics that are visible on the exterior of the garment, rather than visible on the interior of the garment. Further, Jordan teaches a light transmittance in relation to the outer cover only and does not refer to a light transmittance on the interior of the garment. Haarer teaches an absorbent article in which the cover and backsheet are made from pigment-free materials in order to have a transparent periphery to allow for the articles to not be discernible.

Neither Jordan nor Haarer teach or suggest the placement of graphics on the interior of a garment in combination with the limitation that the graphics are visible to the wearer of the garment. A combination of Jordan with Haarer would not lead one of ordinary skill to the claimed invention. A combination of Jordan and Haarer, as proposed by the Action, would result in a diaper utilizing pigment free material. Thus, no graphics would appear in the resulting combination as graphics are made via pigments. This resulting combination of Jordan and Haarer is not the claimed invention. In the absence of evidence that suggests the desirability of combining references in a proposed manner, such combination is not available to preclude patentability under 35 U.S.C. § 103. *King Instrument Corp. v. Otari Corp.*, 767 F.2d 853 (Fed. Cir. 1985). There is no evidence presented in the Office Action of the reasoning why an artisan reviewing only the collective teachings of the references would have found it obvious to selectively pick and

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choose various elements and/or concepts to result in the claimed invention. Therefore, it is respectfully submitted that the rejection is improper and should be reconsidered and withdrawn.

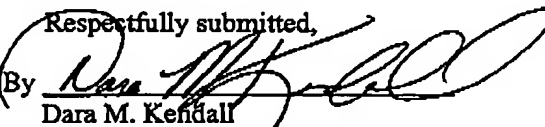
Even if the references are properly combinable, which Applicants contend is not the situation, the references teach away from the current invention. For instance, since Jordan teaches graphics that are visible on the exterior of the article, the reference teaches away from printing on the interior of the outer cover where the graphics are visible on the interior of the article. Jordan also fails to teach printing graphics on the garment facing surface of the bodyside liner in which the graphics are visible on the interior of the article. Haarer does not remedy the teaching away of Jordan. Haarer, itself, teaches away from the claimed invention. Haarer teaches away from the use of pigmented materials and specifically requires the materials to be pigment free. As Haarer teaches using pigment free materials, Haarer is teaching away from the use of graphics all-together as graphics would be made via pigments. It is well known that "a reference may be said to teach away...if it suggests that the line of development flowing from the reference disclosure is unlikely to be productive of the result sought by the applicant." *Tec Air Inc. v. Denso Manufacturing Michigan Inc.*, 192 F.3d 1353 (Fed. Cir. 1999). Based on this apparent teaching away by both Jordan and Haarer, Applicants request reconsideration and withdrawal of the rejection.

Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 103. Early and favorable action in the case is respectfully requested.

This response represents an earnest effort to place the application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1 - 14 is respectfully requested.

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Respectfully submitted,
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